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FAX TRANSMITTAL COVER SHEET

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Message:

Attached are a Notice of Appeal (1 page), Extension (1 page), and a Pre-Appeal Brief Request for Review (6 pages) for:

Applicants: Andy Kenowski et al.

Application No.: 10/823,204

Filed: April 13, 2004

For: MONITORING DEVICE FOR OPERATING CLEAN-IN-PLACE SYSTEM (AS AMENDED)

Group Art Unit: 1746

Examiner: Frankie L. Stinson

Doc Code: AP.PRE.REQ

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): 470037.90718

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on May 25, 2006

Signature: Richard T. Roche

Typed or printed name: Richard T. Roche, 38,599

Application Number	Filed
10/823,204	04/13/2004

First Named Inventor: Andy Kenowski

Art Unit	Examiner
1746	Frankie L. Stinson

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☑ attorney or agent of record. Registration number 38,599
- ☐ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

Richard T. Roche
Signature

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May 25, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

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Matter No. 470037.90718 Doc. No. 5902681

Docket No.: 470037.90718

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Andy Kenowski *et al.*	Group Art Unit:	1746
Application No.:	10/823,204	Examiner:	Frankie L. Stinson
Filed:	April 13, 2004		

For: MONITORING DEVICE FOR OPERATING CLEAN-IN-PLACE SYSTEM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Having filed a Notice of Appeal herewith in the above-identified patent application, Applicants hereby submit this request for pre-appeal review of the final rejection of November 25, 2005.

Status of the Claims

Claims 1-6 are pending and have been finally rejected in the Office Action of November 25, 2005. No amendments have been made after the final rejection. Claims 1-6 could be grouped together with claim 1 being a representative claim.

Summary of Invention

The present invention relates to a clean-in-place system for cleaning an apparatus. The system includes a tank containing a fluid composition (such as a caustic or an acidic cleaning composition) having a measurable physical property (such as pH or conductivity) at a first measured value. The tank has a supply valve and a return valve. A fluid supply conduit is in fluid communication with the supply valve of the

tank and an inlet of the apparatus. A fluid return conduit is in fluid communication with the return valve of the tank and an outlet of the apparatus being cleaned.

A physical property sensor (such as a pH or conductivity sensor) is located in the fluid return conduit for repeatedly sensing the measurable physical property of fluids passing through the fluid return conduit. The sensor generates a physical property signal corresponding to each sensed measurable physical property. A flow rate sensor in the fluid return conduit repeatedly senses the flow rate of fluids passing through the fluid return conduit and generates flow rate signals.

The system includes a controller (such as a programmable logic controller) that is responsive to physical property signals from the physical property sensor and to flow rate signals from the flow rate sensor. The controller provides control signals to the supply valve and the return valve. The controller executes a program stored on the controller to: (i) open the supply valve and the return valve to circulate the fluid composition through the tank and the apparatus, (ii) compare successive physical property signals from the sensor, and (iii) close the return valve at a time after successive physical property signals have a deviation greater than a predetermined amount where the time is calculated in dependence on the flow rate signals.

Issue

In the Office Action of November 25, 2005, claims 1-5 were rejected under 35 USC. § 102(b) as being anticipated by U.S. Pat. No. 6,014,994 to Schmidt ("Schmidt")

Arguments

1. The Office Action Incorrectly Characterizes Language in Claim 1 as Functional Language

The final Office Action states that:

"it is old and well known in various arts to control, in an associated process, and various elements of the system, i.e., valving, pumps, motors as a function of system parameters. The control in Schmidt is clearly capable, through appropriate programming, of performing the recited function."

This statement in the final Office Action appears to address language in claim 1 stating:

> "the controller executing a program stored on the controller to: open the supply valve and the return valve to circulate the fluid composition through the tank and the apparatus, compare successive physical property signals from the sensor, and close the return valve at a time after successive physical property signals have a deviation greater than a predetermined amount, the time being calculated in dependence on the flow rate signals."

It is believed that this language in claim 1 is structural, not functional language.

In this regard, attention is directed to the following statement of the Court of Appeals for the Federal Circuit in *WMS Gaming Inc. v. International Game Technology*, 184 F.3d 1339 (Fed. Cir. 1999):

> "A general purpose computer, or microprocessor, programmed to carry out an algorithm creates "a new machine, because a general purpose computer in effect becomes a special purpose computer once it is programmed to perform particular functions pursuant to instructions from program software." *In re Alappat*, 33 F.3d 1526, 1545, 31 USPQ2d 1545, 1558 (Fed. Cir. 1994) (*en banc*); see *In re Bernhart*, 417 F.2d 1395, 1399-1400, 163 USPQ 611, 615-16 (CCPA 1969) ("[I]f a machine is programmed in a certain new and unobvious way, it is physically different from the machine without that program; its memory elements are differently arranged."). The instructions of the software program that carry out the algorithm electrically change the general purpose computer by creating electrical paths within the device. These electrical paths create a special purpose machine for carrying out the particular algorithm." *WMS Gaming* at 1348.

Present claim 1 recites features of the controller's stored program in which "instructions of the software program that carry out the algorithm electrically change the general purpose computer by creating electrical paths within the device." Thus, under the *WMS Gaming Inc.* test, the program features of claim 1, are not merely functional steps but provide "electrical paths [that] create a special purpose machine for carrying out the

particular algorithm". Accordingly, it is believed that this language in claim 1 is structural language, not functional language.

It is noted that the final Office Action relies on *In re Schreiber*, 128 F.3d 1473 for the proposition that an apparatus must be distinguished from the prior art in terms of structure rather than function. However, because the language in claim 1 is structural language, the reliance on *In re Schreiber* is misplaced.

2. Claim 1 Is Not Anticipated By, Or Obvious Over, U.S. Pat. No. 6,014,994 To Schmidt

It is well settled that "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Looking again at claim 1, it can be seen that the controller of the system executes "a program stored on the controller to: open the supply valve and the return valve to circulate the fluid composition through the tank and the apparatus, compare successive physical property signals from the sensor, and close the return valve at a time after successive physical property signals have a deviation greater than a predetermined amount, the time being calculated in dependence on the flow rate signals."[1] Review of Schmidt did not locate these features in the system of Schmidt. Therefore, all of the features of claim 1 are not " found, either expressly or inherently described, in" Schmidt. Accordingly, claim 1 is not anticipated by Schmidt.

Regarding any possible obviousness rejection of claim 1 over Schmidt, the final Office Action states that: "the control in Schmidt is clearly capable, through appropriate

[1] As noted above from *WMS Gaming*, the instructions of the software program that carry out the algorithm electrically change the microprocessor by creating electrical paths within the device. These electrical paths create a special purpose machine for carrying out the particular algorithm.

programming, of performing the recited function." It is submitted that this statement is not sufficient evidence to establish *prima facie* obviousness over Schmidt.

In *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990), the Court of Appeals for the Federal Circuit overturned a Board of Patent Appeals decision in which the Board concluded that a prior art machine was capable of being operated in a fashion as recited in a claim under appeal. The CAFC stated that

> "while [the prior art] apparatus may be capable of being modified to run the way [the Applicant's] apparatus is claimed, there must be a suggestion or motivation in the reference to do so. *See In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) ("The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.")." *In re Mills* at 682.

Therefore, even if the Schmidt device could operate as the system of claim 1 of the present application (and the Applicants do not concede that it could), in order to support an obviousness rejection, Schmidt would need to suggest that the Schmidt device should be operated as the system of claim 1. It is submitted that Schmidt fails to provide such a suggestion and therefore, claim 1 is not obvious over Schmidt.

Because the Patent Office has failed to come forward with sufficient evidence of anticipation and obviousness in view of U.S. Patent No. 6,014,994 to Schmidt, the Applicants respectfully request reversal of the final rejection in the application.

Respectfully submitted,

Dated: May 25, 2006

By: _____

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